

Remarks

The non-final Office Action dated October 17, 2008, lists an objection to the drawings and the following rejections: claims 1-10 stand rejected under 35 U.S.C. § 112(2); claims 12-13 stand rejected under 35 U.S.C. § 102(b) over the Bowes reference (U.S. Patent Pub. 2002/0182516); claims 1-3 stand rejected under 35 U.S.C. § 103(a) over the Ki reference (US Patent Pub. 2003/0068565) in view of the Bowes reference; and claims 7-11 stand rejected under 35 U.S.C. § 103(a) over the Ki reference. The Office Action indicates that claims 4-6 would be allowable if rewritten in independent form. In this discussion set forth below, Applicant traverses each rejection and does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise. The amendments are not intended to overcome any issue of patentability but rather, as with the new claims, are presented to more clearly articulate aspects of the present invention; the new claims are directed to subject matter previously considered and are believed to be patentable for the reasons discussed below in connection with the underlying independent claims.

The objection to Figs. 6-7 should be overcome by way of the enclosed, proposed-replacement figures which depict text in the boxes in a manner consistent with the originally-filed specification.

The §112(2) rejection should be withdrawn as this antecedent basis issued is, at best, merely objectionable with the “opposite corner” being properly introduced after the previously-recited corner. *See* M.P.E.P. § 2173.05(e) and related assertions in the Office Action. Notwithstanding, the amendments to claims 1, 7-8 and 10 render this issue as being moot.

The §102(b) rejection of claims 12-13 should be withdrawn as the ‘516 (Bowes) reference does not teach or suggest the claimed invention. Contrary to the assertions in the Office Action, this reference does not even mention flare, no less measuring or accounting for the effects of flare. The Office Action’s reference to paragraph 0036 of this reference appears to confuse the issue of focal-related adjustments with those concerning the effects of flare. These issues being very different, Applicant does not interpret the Office Action as implicitly asserting that this paragraph from the ‘516 reference would teach the skilled artisan, to any degree, how to account for the effects of

flare as claimed. Accordingly, Applicant submits that the §102(b) rejection must be withdrawn.

Each of the §103(a) rejections must also be withdrawn as the asserted modification of the '565 (Ki) reference (with or without the cited teachings of the '516 reference) generally fails to satisfy the requirements for maintaining a § 103 rejection. See M.P.E.P. § 2143. As noted in the Office Action, the cited teachings do not correspond to the claimed invention. For the rejection of claims 1-3, paragraphs 16, 17 and 18 of the Office Action explicitly acknowledge this lack of correspondence in the '565 reference with regards to significant aspects of Applicant's claimed invention. These same paragraphs then attempt to reconstruct Applicant's claimed invention improperly by explaining how different wafers, extracted from alternative processes in the '565 reference, can be used to develop yet another process which could be viewed as corresponding to the claimed invention (compare, *e.g.*, paragraph 17 of the Office Action with the teachings of alternative processes at paragraph 0056 of the '565 reference). According to the rule and law under §103, however, relied-upon teachings from an asserted reference must emanate from the same embodiment. *See, e.g.*, M.P.E.P. §2131 further stating that various portions of a reference cannot be asserted together to anticipate a claim unless the reference arranges the limitations as they are arranged in the claim.

Further, the asserted modification carries no reasonable expectation of success or motivation, and fails to articulate a real basis for the combination. The M.P.E.P. (with recent controlling authority) is clear on the need to articulate a logical basis for combining references, particularly when the primary reference is being modified by the teaching in another reference. *See, e.g.*, M.P.E.P. § 2142, *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (U.S. 2007) ("A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art."). This *KSR* decision cited with approval the basic § 103 tenet that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (as cited in *KSR*).

For the instant rejections, there does not appear to be any basis for combining the cited teachings of these references except that the skilled artisan would implement Applicant's claimed invention (including the many aspects that are not at all disclosed in the '565 reference) by way of routine experimentation. The Office Action does not indicate why the skilled artisan would be experimenting or what problem would be at issue and the subject of such experimentation. According to the M.P.E.P. and the clear standards set forth by the USPTO (incorporating the *KSR* decision), the Office Action has satisfied neither the showing of likelihood of success requirement nor the motivation requirement.

Applicant's position is further substantiated when considering the overall and specific purpose of the '565 (Ki) reference. As expressed in most every claim and discussed throughout (including the summary and detailed description sections), the objective of the '565 reference is to account for flare effects at each exposure stage by using test patterns on test wafers as shown in figures 3, 6 and 10-14. In an effort to establish correspondence to the claimed invention, the proposed modification of the '565 reference would replace the test patterns and/or test wafers. The extreme nature of the proposed changes should be sufficient to appreciate that the skilled artisan would not implement this modification of the '565 reference. Moreover, because the nature of the proposed changes would undermine the purpose and implementation of the '565 reference, the M.P.E.P. explains that such a modification evidences that the prior art teaches away. *See, e.g.,* M.P.E.P. § 2143.01, *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines purpose of the main reference.)

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Peter Zawilski, of NXP Corporation at (408) 474-9063 (or the undersigned).

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Attachment: Eight Replacement Drawing Sheets

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